

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Office Action dated May 16, 2007, wherein the Examiner maintained her rejections set forth in the March 19, 2007 Advisory Action (hereinafter the “Advisory Action”) and, upon further consideration determined that Brothers (U.S. 2003/0121659) (“*Brothers*”) anticipates claim 1’s element concerning the colloidally stabilized latex remaining “substantially stable in the presence of salt.”

Status of the Claims

Claim 1 is currently amended.

Claim 36 is new.¹

Claims 7 and 17-35 were previously canceled.

Claims 2-6, and 9-16 are in their original form.

Claims 1-6, 8-16 and 36 are currently pending in this application.

Rejections under 35 USC §§ 102(a) & (e)

Claims 1, 2, 4, and 8-16 are rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by *Brothers*. As explained by the Court of Appeals for the Federal Circuit: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants have amended claim 1 to overcome *Brothers*’s anticipatory rejection. Claim 1 has been amended to read:

¹ New claim 36 has been added to capture the concept formerly provided in canceled claim 7 (which had been included in the previous incarnation of claim 1). Support for new claim 36 is found in the specification. See Application at ¶ [0020] (“The colloidally stabilized latex has a relatively high tolerance to salts. Thus, it desirably remains stable in the presence of the salts contained in the sealant compositions and in the presence of salts that it may encounter in the wellbore without the need to introduce additional stabilizing surfactants . . .”).

1. A method of servicing a wellbore in contact with a subterranean formation, comprising: displacing a sealant composition comprising a colloidally stabilized latex into the wellbore; wherein the sealant composition does not comprise an epoxy resin or *zinc oxide*.

See claim 1 supra (emphasis added). Support for the current amendment to claim 1 is found in the specification. *See, e.g.*, Application at ¶ [0021] (“In an embodiment, the sealant composition may include the following components: . . . vulcanization accelerators such as fatty acids such as stearic acid, metallic oxides such as *zinc oxide*, aldehyde amine compounds, guanidine compound, and disulfide thiuram compounds; vulcanization retarders . . .”) (emphasis added); *In re Johnson*, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”); and MPEP § 2173.05(i) (“If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.”).

Brothers discloses that its “sealing composition” must include zinc oxide. *See, e.g.*, *Brothers* at ¶ [0004] (“A sealing composition according to the present embodiment basically comprises a mixture of latex, dithio carbamate, *zinc oxide*, and sulfur, for sealing a subterranean zone penetrated by a well bore. The sulfur containing component vulcanizes the latex to form a solid mass which seals the zone.”) (emphasis added); ¶ [0005] (“In a first embodiment, the composition comprises a mixture of latex, dithio carbamate, *zinc oxide*, and sulfur.”) (emphasis added); ¶ [0009] (“In a second embodiment, the composition comprises a mixture of latex, dithio carbamate, *zinc oxide*, sulfur, and a foaming agent, wherein the mixture is foamed.”) (emphasis added); *see also* U.S. Patent No. 6,668,928 (*Brothers* as issued by the U.S.P.T.O. on December 30, 2003) (Claim 1 -- “1. A method of sealing a subterranean zone penetrated by a well bore comprising: preparing a sealing composition comprising latex, dithio carbamate, *zinc oxide*, sulfur

and acetylenic alcohol; placing the sealing composition into the subterranean zone; and allowing the sealing composition to set therein.”) (emphasis added).

Because *Brothers*'s disclosure requires zinc oxide be included in all of its sealing compositions, and because claim 1 of the instant application has been amended to exclude zinc oxide from the instant application's sealant composition, *Brothers* cannot be read to anticipate the instant application.

Based on the foregoing, independent claim 1 should be allowed as it is not anticipated by *Brothers*. Additionally, because dependent claims 2, 4, and 8-16 (and newly added 36) depend on claim 1, dependant claims 2, 4, and 8-16 (and 36) should be allowed because they are not anticipated by *Brothers*.

Rejections under 35 USC § 103(a)

Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) was being unpatentable over *Brothers* in view of Krishanan (U.S. 5,900,451) (“*Krishanan*”). Similarly, claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brothers* in view of Griffith et al. (U.S. 6,448,206) (“*Griffith*”). Thus, claims 3, 5, and 6 stand or fall on the application of *Brothers* to the claims. The requirements for establishing a *prima facie* case of obviousness are well established:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As explained in reference to the § 102 rejections above, *Brothers* fails to teach or suggest the limitations contained in claims 3, 5, and 6. The Office Action does not cite *Krishanan*, *Griffith*, or other prior art references, to teach the limitations that are absent from *Brothers*. Thus, the Office Action does not establish a *prima facie* case of obviousness as to claims 3, 5, and 6 which are allowable over the cited prior art.

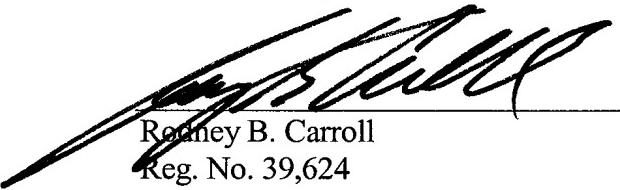
CONCLUSION

Consideration of the foregoing and reconsideration of the application, and withdrawal of the rejections are respectfully requested by the Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated May 16, 2007 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.

Date: 8-16-07


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